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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,892	01/26/2004	Tsutomu Okada	17376	9699

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EXAMINER	
KASZTEJNA, MATTHEW JOHN	

ART UNIT	PAPER NUMBER
3739	

MAIL DATE	DELIVERY MODE
05/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,892	OKADA, TSUTOMU	
	Examiner	Art Unit	
	Matthew J. Kasztejna	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on February 14, 2007, amended claims 2 and 13 are acknowledged. The following new grounds of rejection are set forth:

Claim Objections

Claims 14-15 are objected to because of the following informalities: claims 14-15 are dependent from claim 1, which has been canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (U.S. Patent No. 6,059,719) in view of Suzuki (U.S. Patent No. 6,068,063).

In regard to claims 2-7 and 11-13, Yamamoto et al. teach a medical instrument system 1 using a diathermic snare and an endoscope in combination with each other, the endoscope including an inserting section which is to be inserted into a body cavity, and includes a distal end and a proximal end, and a cylindrical cap section 6A mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection, wherein the engagement projection includes a bent

portion which is bent inward at the distal end of the cap section (see Figs. 1-2); wherein the diathermic snare comprises: a flexible sheath 23 having a distal end and a proximal end; an operation wire 22 inserted into the flexible sheath to be movable forwards and backwards, and having a distal and a proximal end; a snare wire 94 coupled to the distal end of the operation wire, and including a loop section 93 which expands to loop (see Fig. 7); an operating section 12 coupled to the proximal end of the flexible sheath, the operating section including a guide member and a slider, the guide member, extending in axial direction of the flexible sheath, the slider being movable forwards and backwards in the axial direction of the flexible sheath, and coupled to the proximal end of the operating wire; wherein the slider is moved forwards along the guide member, loop section of the snare wire is projected from the distal end of the sheath, the snare wire expands to loop and the loop section expands along the inner circumference surface of the engagement portion, and when the slider is moved backwards along the guide member, the loop section of the snare wire is retreated into the sheath; and wherein the loop section expands along the inner circumference of the projection (see Figs. 9-12 and 15 and Col. 10, Lines 5-67). Yamamoto et al. are silent with respect to a distal-end bent portion provided at the distal end of the loop section. Suzuki teaches of an analogous medical instrument system using a diathermic snare and an endoscope in combination with each other wherein the snare 16 may be formed of stainless spring steel, a superelasticity alloy wire material such as an Ni--Ti alloy, or a resin such as polyamide, which are elastic sufficient to expand and contract and have a sufficient sharpness as knives. Furthermore, the expansible section 16a of the snare is bent at a

predetermined angle with respect to the rear support section (see Figs. 1-2 and Col. 7, Lines 30-53). It would have been obvious to one skilled in the art at the time the invention was made to include a distal-end bent portion provided at the distal end of the loop section in the apparatus of Yamamoto et al. to allow for greater efficiency in grasping tissue during surgical procedures as taught by Suzuki.

Claims 2-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakada et al. (U.S. Patent Application Publication No. 2001/0053909) in view of Suzuki (U.S. Patent No. 6,068,063).

In regards to claims 2-7 and 11-16, Nakada et al. teach a diathermic snare used in combination with an endoscope, the endoscope 3 including an inserting section 4 with is inserted into a body cavity and which has a distal end and a proximal end, and a cylindrical cap section 1 mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection having a bending portion that bends inward at the distal end of the cap section (see Figs. 1 and 3), wherein the diathermic snare comprises: an elongate flexible sheath 9 having a distal end and a proximal end; an operating wire inserted into the sheath so as to move forward and backward and having a distal end and a proximal end; a snare wire 16b coupled to the distal end of the operating wire and having a loop section which expands like a loop (see Fig. 4); an operating section coupled to the proximal end of the sheath and including a operating section coupled to the proximal end of the sheath and including a guide member extending in an axial direction of the sheath and a slider which moves forward and backward in the axial direction of the sheath along the guide

member and which is coupled to the proximal end of the operating wire; the loop section of the snare wire projecting from the distal end of the sheath, the snare wire expanding like a loop, and the loop section expanding along an inner circumference of the engagement projection when the slider moves toward along the guide member (see Figs. 1 and 3-6); wherein the cap section has an inclined plane corresponding to a plane of the cap section which is inclined to the axial direction of the sheath (see Figs 7-8). Nakada et al. are silent with respect to a distal-end bent portion provided at the distal end of the loop section. Suzuki teaches of an analogous medical instrument system using a diathermic snare and an endoscope in combination with each other wherein the snare 16 may be formed of stainless spring steel, a superelasticity alloy wire material such as an Ni--Ti alloy, or a resin such as polyamide, which are elastic sufficient to expand and contract and have a sufficient sharpness as knives. Furthermore, the expansible section 16a of the snare is bent at a predetermined angle with respect to the rear support section (see Figs. 1-2 and Col. 7, Lines 30-53). It would have been obvious to one skilled in the art at the time the invention was made to include a distal-end bent portion provided at the distal end of the loop section in the apparatus of Nakada et al. to allow for greater efficiency in grasping tissue during surgical procedures as taught by Suzuki.

In regards to claims 8-10 and 17-18, Nakada et al. teach a diathermic snare used in combination with an endoscope, wherein cap section has an inclined plane corresponding to a plane of the distal end of the cap section which is inclined to the

axial direction of the sheath; and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8).

Response to Arguments

Applicant's arguments with respect to claims 2-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK

5/1/7

LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700